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SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1942

No. 302

HARRIET J. FABER, Executrix of the Estate of Henry B. Faber, Deceased, and ETHEL L. DRIGGS, Executrix of the Estate of Louis L. Driggs, Jr., Deceased,

Petitioners,

vs.

TRIUMPH EXPLOSIVES, INC. and GLENN L. MARTIN COMPANY,

Respondents.

ON PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE FOURTH CIRCUIT.

BRIEF FOR THE RESPONDENTS IN OPPOSITION.

Harold F. Watson,
Attorney and Counsel for Respondents.

Watson, Cole, Grindle & Watson,
Of Counsel.

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BRIEF FOR THE RESPONDENTS IN OPPOSITION.

Opinions Below.

The Opinion of the District Court is reported at 37 Federal Supplement, 766. The original Opinion of the Circuit Court of Appeals is listed in Vol. 125 of the Federal Reporter, 2nd Series, but was withdrawn from publication by order of the Court. It is published at 52 U. S. Patents Quarterly, 199. The Opinion of the Circuit Court of Appeals on rehearing is reported at 128 Federal Reporter, 2nd Series, 444.

Jurisdiction.

The jurisdiction of this Court is invoked under Section 240(a) of the Judicial Code, as amended February 13, 1925.

Questions Presented.

The Court below held the two patents in question to be invalid for want of invention, and also held claim 1 of patent No. 1,712,382 to be invalid by reason of an improper disclaimer. The petitioner seeks review on three questions (Petition, page 2). We assert that none of the three questions is, in fact, properly predicated upon the decision rendered by the Circuit Court of Appeals, or constitutes a ground for review by this Court.

Statutes Involved.

The statutes involved are as follows:

R. S. 4886 (35 U. S. C. A. § 31):

Inventions patentable

Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, or who has invented or discovered and asexually reproduced any distinct and new variety of plant, other than a tuber-propagated plant, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than one year prior to his application, and not in public use or on sale in this country for more than one year prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor. R. S. § 4886; March 3, 1897, c. 391, § 1, 29 Stat. 692; May 23, 1930, c. 312, § 1, 46 Stat. 376; Aug. 5, 1939, c. 450, § 1, 53 Stat. 1212.

R. S. 4917 (35 U. S. C. A. § 65):

Disclaimer

Whenever, through inadvertence, accident, or mistake, and without any fraudulent or deceptive inten-

tion, a patentee has claimed more than that of which he was the original or first inventor or discoverer, his patent shall be valid for all that part which is truly and justly his own, provided the same is a material or substantial part of the thing patented; and any such patentee, his heirs or assigns, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of such parts of the thing patented as he shall not choose to claim or to hold by virtue of the patent or assignment, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, attested by one or more witnesses, and recorded in the Patent Office; and it shall thereafter be considered as part of the original specification to the extent of the interest possessed by the claimant and by those claiming under him after the record thereof. But no such disclaimer shall affect any action pending at the time of its being filed, except so far as may relate to the question of unreasonable neglect or delay in filing it. R. S. § 4917.

Summary of Argument.

I. The disclaimer question stated by the petitioners is not presented in this case, for the following reasons:

1. (a) If the disclaimer added an element to the claims, as respondents contend and as the Court below held, it is clearly invalid under recent decisions of this Court. (b) If it did not add the element "cartridge casing" to the claims, then the disclaimer purports to define an element which is not in the claim, and is a nullity. In either case, the first question stated by the petitioner is not presented for determination.

2. The disclaimer is improper for the reason that it was not filed for any reason within the permissive scope of the statute, and the claim is invalid for that reason. The question stated by the petitioner, therefore, does not arise.

3. The claim in question was held invalid for lack of invention, irrespective of the disclaimer.

II. Both patents in suit were held invalid for lack of invention. The patents have not been litigated in any Circuit other than the Fourth. In reaching its decision, the Court below did not come into conflict with any applicable decisions of this Court, or of any other Circuit Court of Appeals. No novel question of law is involved. There is, therefore, no proper ground for asking review by this Court of the proceedings below.

ARGUMENT.

I. The Disclaimer Question stated by petitioner is not presented in this case.

1. (a) Claim 1 of patent No. 1,712,382, and the disclaimer pertaining thereto, are both printed at page 13 of petitioners' brief. The claim reads in part "A muzzle loading low pressure fire arm, adapted to be used with fixed ammunition provided with a cartridge case, comprising a pistol grip * * *." In short, the cartridge case is mentioned only as a part of the ammunition with which the claimed firearm is "adapted to be used." The disclaimer purports to restrict "the element 'cartridge casing' of said Claim 1 * * *." Obviously this was an attempt to add the cartridge case as an element of the claim, which it was not before, and the Court below properly so held. The claim is accordingly invalid under recent decisions of this Court. *Altoona Publix Theatres* v. *American Tri-Ergon Corp.*, 294 U. S. 477; *Milcor Steel Co.* v. *George A. Fuller Co.*, 62 Sup. Ct. 969 (April 27, 1942).

In any event, since the finding of the Court below was to the effect that an element was added by the

disclaimer, the question stated by the petitioners is not presented for determination by this Court.

(b) It is clear that the "cartridge case" was not an element of the originally claimed combination. This is forcibly demonstrated by the Opinion of the Circuit Court of Appeals as quoted at page 9 of the petitioners' brief. That being so, if the disclaimer did not add an element to the claim, it only restricted an element which is not and never was in the claim, and is a nullity. In that case, the question stated by petitioners is not presented for determination by this Court.

2. The record shows, by the testimony of the co-inventor Driggs (pages 123, 124 of the printed record) that the disclaimer was not filed because the inventors had claimed "more than that of which (they were) the original or first inventor(s)", as permitted by the statute, but was filed to correct a real or supposed inadequacy in the specification. The statute does not authorize the filing of disclaimers for such a purpose, and the disclaimer is therefore invalid. For this additional reason, the question stated by the petitioners is not presented for determination by this Court.

3. The Court below held both claims of patent No. 1,712,382 to be invalid for lack of invention in view of the disclosures of the prior art. This holding, insofar as claim 1 is concerned, was made without regard to whether or not the disclaimer was effective, as is perfectly apparent from the reasoning employed (128 F. (2d) at pages 446, 447; pages 200-202 of this record). Because of this circumstance, there is no necessity for this Court to determine the validity or effect of the disclaimer.

II. There is no other ground for review by this Court of the proceedings below.

The second and third questions framed by the petitioners (Petition, page 2) are not, in fact, presented by the record. The Court below did not find the disclosures of the prior art to be "inoperative", but quite the contrary. It is true that the disclosures were characterized as incomplete, in the statement that "None of these French patents purports to show a complete structure consisting of a fire arm and fixed ammunition." Thus, Vaxelaire does not show, in the drawing, the contents of the cartridge, nor the complete firing mechanism of the pistol. One of the Rollet patents shows no pistol at all, and the other shows a pistol only in outline. But the details omitted from these prior patents were conventional at the date of their issue, and have nothing to do with the alleged inventions of the patents in suit.

It is quite clear that the disclosures of the prior patents are entirely adequate in respect to the points actually at issue, which is all that is required.

The Opinion of the Court below shows that, so far as they were relevant, these disclosures were quite clear and understandable to the Court. Therefore, the question of the effect of "foreign patents disclosing inoperative and incomplete devices" does not arise in the present case.

Petitioners' third question is whether a United States patent covering a combination of elements, "ineffective separately", can be invalidated by "showing the elements separately in a series of foreign patents." This question is not presented by the record. It is true that the Court below, in finding the patents invalid, considered together the disclosures of the several foreign patents, but the Court did not attempt to "anticipate" the claims by combining elements from the prior patents. On the contrary, the Court took the view that, in the light of the prior state

of the art, of which every patentee is conclusively presumed to have knowledge, the patentees of the patents in suit had made no invention; and that the patents were accordingly invalid, quite irrespective of the form and content of their claims. Upon this ground of invalidity the Court was entitled to consider not only a "series of foreign patents", but the entire sum of human knowledge at and prior to the date of the alleged invention. Petitioners' third question, therefore, is not presented for determination on the present record.

Morover, even if the questions as framed by the petitioners were presented in this case, there would be no proper ground for the petition. No new question of law is presented. The Court below, in reaching its decision, did not come into conflict with any decision of this Court or of any other Circuit Court of Appeals; and no question of special importance is involved.

Conclusion.

The decision of the Court below is correct and in accordance with well-established principles of law. There is no conflict or other ground for review by this Court. The petition should be denied.

Respectfully submitted,

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WATSON, COLE, GRINDLE & WATSON,
Of Counsel.

(1978)